



Docket No.: F1866.0054

(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Masahiko Nakayama

Application No.: 09/705,050

Confirmation No.: 3890

Filed: November 2, 2000

Art Unit: 2124

For: FIR FILTER AND RAMP - UP / - DOWN  
CONTROL CIRCUIT USING THE SAME

Examiner: C. C. Do

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on August 5, 2004, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2), and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

10/06/2004 SDENB0B1 00000078 09705050  
340.00 OP  
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This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
  - II. Related Appeals and Interferences
  - III. Status of Claims
  - IV. Status of Amendments
  - V. Summary of Invention
  - VI. Issues
  - VII. Arguments
  - VIII. Claims Involved in the Appeal
- Appendix A Claims

**I. REAL PARTY IN INTEREST**

The real party in interest for this appeal is:

NEC Corp.

**II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS**

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

### **III. STATUS OF CLAIMS**

#### **A. Total Number of Claims in Application**

There are 20 claims pending in application.

#### **B. Current Status of Claims**

1. Claims canceled: 1.
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: 2-21.
4. Claims allowed: None.
5. Claims rejected: 2-21.

#### **C. Claims On Appeal**

The claims on appeal are claims 2-21.

### **IV. STATUS OF AMENDMENTS**

Applicant filed an Amendment After Final on April 19, 2004. The Examiner responded in Advisory Action mailed on June 16, 2004, indicating that the amendments to claims 2-5, 7-10, and 17 would be entered. Applicant filed a Second Amendment After Final on July 14, 2004 that did not contain amended claims but did contain an argument

traversing the rejections. The Examiner responded in an Advisory Action mailed on August 26, 2004, indicating that the Amendment would be entered.

In addition, Applicant has corrected a typographical error in claim 1. As recited in Applicant's December 3, 2003 Amendment, claim 1 properly recites: "wherein a FIR filter output is derived from product outputs of the multiplying means." However, due to the typographical error, in the later April 19, 2004 Amendment After Final, claim 1 improperly recites: "wherein a FIR filter output is derived from the product outputs of the n multiplying circuits means." Applicant sets forth the correct language in Appendix A.

Accordingly, the claims enclosed herein as Appendix A incorporate the amendments made subsequent to final rejection.

## V. SUMMARY OF INVENTION

The present invention relates to controlling the transmission power level of a transmission circuit in a radio transmitter / receiver. More particularly, it claims a Finite Impulse Response (FIR) filter employing a ramp-up/-down control circuit using the FIR filter.

As provided in the specification, it is customary for a CDMA transmitter to contain a digital section, analog section, and antenna. (See page 1, lines 24-26; Fig. 10.) A FIR filter for limiting bandwidth is disposed in the digital section. (See page 2, lines 1-2.) At the start and end of transmission (or upon burst transmission in TDMA), the spectrum of the transmission signal is spread, resulting in interference with other channels. (See page 2, lines 6-15.) Thus, a standard ramp-up and ramp-down time section is given for transmission data to limit channel interference. (See page 2, lines 18-20.)

In the conventional FIR filter, transmission data is shifted through an n-bit shift register and then fed through a memory into which is input a one-bit burst timing signal and clock. (See Fig. 11; page 2, lines 23-28 - page 3, lines 2-5.) As the tap number (number of shift register stages) increases, so do memory requirements and resulting overall circuit scale. (See page 3, lines 6-14.) In contrast to the prior art, the present invention enables better memory management and scalability while maintaining effective ramp-up /-down functionality.

Further, as distinguished from the prior art, the present invention claims a FIR filter wherein there is an n-to-n relationship between an n-bit shift register into which transmission data is fed and n switch elements that accept the output of such register. Additionally, again as distinguished from the prior art, the present invention claims a FIR filter including a switch element that is able to select either a fixed value or a FIR filter coefficient.

## VI. ISSUES

Are claims 2, 4-7, 10, 14, 16-17, 19 and 21 patentable under 35 U.S.C. § 102(b) over Hidemitsu, J.P. 411088119A?

Are claims 3 and 11-12 patentable under 35 U.S.C. § 103(a) over Hidemitsu in view of Shinde, U.S. Patent No. 6,192,386?

Are claims 8-9, 13, 15, 18 and 20 patentable under 35 U.S.C. § 103(a) over Hidemitsu in view of Shinde in further view of the admitted prior art?

## VII. GROUPING OF CLAIMS

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below:

Group Claim(s)

I. 2-16.

II. 17-21.

## VIII. ARGUMENT

In the Final Office Action mailed February 6, 2004, the Examiner finally rejected claims 2, 4-7, 10, 14, 16-17, 19 and 21 under 35 U.S.C. § 102(b) over Hidemitsu, J.P. 411088119A; claims 3 and 11-12 under 35 U.S.C. § 103(a) over Hidemitsu in view of Shinde, U.S. Patent No. 6,192,386; and claims 8-9, 13, 15, 18 and 20 under 35 U.S.C. § 103(a) over Hidemitsu in view of Shinde in further view of the admitted prior art.

There are three independent claims in the present application: 2, 10 and 17. For the following reasons, the rejections thereon under § 102 must be reversed. Further, the rejections on claims dependent thereon under §§ 102 and 103 must also be reversed.

### A. Independent Claims 2 and 10 Are Patentable Over The Cited Art.

#### 1. Claim 2 is Patentable Under § 102.

The Examiner rejected independent claim 2 under § 102(b) over Hidemitsu. This rejection is erroneous for the following reasons.

Independent claim 2 requires (emphasis added): a first n-bit shift register, n-switching means, n unique control signals, and a second n-bit register. Hidemitsu does not show an n-bit shift register, n switching means, n unique control signals, and a second n-bit register.

In the rejection of claim 2 over Hidemitsu, the Examiner indicates that the implementation of Hidemitsu discloses: a first n-bit shift register in its elements 2-5 [thus,  $n = 4$ ] (Final Office Action, Second Advisory Action); n switching means 6-10 [thus,  $n = 5$ ] (Final Office Action, Second Advisory Action); n unique control signals S1-S5 [thus,  $n = 5$ ] (Final Office Action, First Advisory Action, Second Advisory Action); and a second n-bit register 108-113 [thus,  $n = 6$ ] (First Advisory Action).

Thus, in the implementation of Hidemitsu, n is simultaneously 4, 5 *and* 6. However, Applicant explicitly claims an “n-to-n-to-n-to-n” relationship. That is, “n” must be an identical value for each of the first n-bit shift register, n switching means, n unique control signals and second n-bit shift register. Hidemitsu shows “n” of 4, 5 and 6, which are not identical values.

Further, the Examiner indicates that Hidemitsu shows a first n-bit shift register where  $n=5$ . Applicant respectfully disagrees, because in Hidemitsu  $n = 4$ . As the Examiner admits in the Second Advisory Action (emphasis added):

Hidemitsu discloses in Figure 7 an FIR filter comprising . . . a first n-bit shift register in particular n being a natural number  $n = 5$  as  $x(1) \dots x(5)$  for progressively shifting the input data through successive stage bits (the data “IN” is shifting to the right *into the register*), [and] n switching means (6-10) . . . .

As the Examiner indicates, data “IN”, shown as item 1 in Hidemitsu, is shifted *into the register* shown as 2-5. “IN” itself is not part of the register. Based on Hidemitsu Fig. 7

and the Examiner's description thereof, the shift register has four bit-registers. Thus,  $n = 4$ .

For the reasons given above, independent claim 2 is patentable under § 102 over Hidemitsu, and the rejection thereon must be reversed. Further, the § 102 rejections as to claims 4-7 stand or fall with claim 2, on which they depend, and must also be reversed.

In addition, claims 3 and 8-9, which depend from claim 2, are patentable under § 103 over the cited art. Neither Hidemitsu, Shinde nor the admitted prior art teaches or suggests the  $n$ -to- $n$ -to- $n$ -to- $n$  relationship described above, required in each of claims 3, 8 and 9. Thus, Shinde and the Admitted Prior Art do not cure the deficiencies of Hidemitsu. Applicant therefore respectfully submits that a *prima facie* case of obviousness has not been made out because the references, even if combined, do not teach each and every claim limitation. M.P.E.P. § 2143.

## 2. Independent Claim 10 is Patentable Under § 102.

The Examiner has rejected independent claim 10 under § 102(b) over Hidemitsu. This rejection is erroneous for the following reasons.

To begin, in the First Advisory Action, the Examiner stated that "claim 10 is also rejected under the same rationale in the rejection of rejected claim 2." The Examiner did not change this position in the Second Advisory Action. Because Applicant has shown that claim 2 is patentable over the cited art, and the Examiner indicated that claim 10 is rejected under the same rationale as that of claim 2, the rejection of claim 10 must be reversed.

Moreover, independent claim 10 requires (emphasis added): a first  $\underline{n}$ -bit shift register,  $\underline{n}$  unique control signals, an  $\underline{n}$ -bit combining circuit, and  $\underline{n}$  multipliers. Hidemitsu

does not show a first n-bit shift register, n unique control signals, an n-bit combining circuit, and n multipliers.

In the rejection of claim 10 over Hidemitsu, the Examiner indicates that Hidemitsu discloses: a first n-bit shift register in its elements 2-5 [thus, n = 4] (Final Office Action, Second Advisory Action); n unique control signals S1-S5 [thus, n = 5] (Final Office Action, First Advisory Action, Second Advisory Action); and n multiplying elements 11-15 [thus, n = 5] (Final Office Action, Second Advisory Action). The Examiner does not identify where Hidemitsu contains the n-bit combining circuit as claimed, but simply states in the Final Office Action: “Re claim 10, it has the similar features stated in claim 1 [sic, 2]. Thus, claim 10 is also rejected under the same rationale in the rejection of rejected claim 1 [sic, 2].”

Thus, in the implementation of Hidemitsu, n is simultaneously 4 *and* 5. However, Applicant claims an n-to-n-to-n relationship. That is, as claimed, “n” must be an identical value for each of the first n-bit shift register, n unique control signals, and n multipliers. And again, the implementation of Hidemitsu shows “n” of 4 and 5, which are not identical values.

For the reasons given above, independent claim 10 is patentable over Hidemitsu under § 102, and the rejection thereon must be reversed. Further, the § 102 rejections as to claims 14 and 16 stand or fall with claim 10, from which they depend, and must also be reversed.

In addition, claims 11-13 and 15, which depend from claim 10, are patentable under § 103 over the cited art. Neither Hidemitsu, Shinde nor the Admitted Prior Art teaches or suggests the n-to-n-to-n relationship described above, required in each of claims 11-13 and 15. Thus, Shinde and the Admitted Prior Art do not cure the deficiencies of

Hidemitsu. Applicant therefore respectfully submits that a *prima facie* case of obviousness has not been made out because the references, even if combined, do not teach each and every claim limitation. M.P.E.P. § 2143.

**B. Independent Claim 17 is Patentable Over The Cited Art.**

The Examiner has rejected independent claim 17 under § 102(b) over Hidemitsu. This rejection is erroneous for the following reasons.

Nowhere does Hidemitsu show, as required by claim 17, a FIR filter including (emphasis added): “a switch coupled to the control circuit, coupled to the fixed value circuit and coupled to the FIR filter coefficient circuit, each switch selecting either the fixed value or the FIR filter coefficient . . .” Hidemitsu fails to teach or suggest a switch that can select a FIR filter coefficient.

None of Figures 1, 7 and 11 of Hidemitsu, referenced by the Examiner, shows that a FIR filter coefficient value is an input to any switch. The switches shown in Hidemitsu either switch between the data and 0 (Figure 1), or between the data and a code converter that merely appears to invert the value of the delay element (Figure 7); further, Figure 11 does not disclose any switches whatsoever. Thus, Hidemitsu nowhere teaches or suggests a switch that can select “either the fixed value or the FIR filter coefficient”, as required by claim 17 of the present invention.

For the reasons given above, independent claim 17 is patentable over Hidemitsu under § 102, and the rejection thereon must be reversed. Further, the § 102 rejections as to claims 19 and 21 stand or fall with claim 17, on which they depend, and must also be reversed.

In addition, claims 18 and 20, which depend from claim 17, are patentable under § 103 over the cited art. Neither Hidemitsu, Shinde nor the Admitted Prior Art teaches or suggests a switch that can select “either the fixed value or the FIR filter coefficient”, as required by claim 17 of the present invention. Thus, Shinde and the Admitted Prior Art do not cure the deficiencies of Hidemitsu. Applicant therefore respectfully submits that a *prima facie* case of obviousness has not been made out because the references, even if combined, do not teach each and every claim limitation. M.P.E.P. § 2143.

## IX. CLAIMS INVOLVED IN THE APPEAL

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Applicant on April 19, 2004.

Dated: October 5, 2004

Respectfully submitted,

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APPENDIX A**Claims Involved in the Appeal of Application Serial No. 09/705,050**

1. (Canceled)
2. (Previously presented): A Finite Impulse Response (FIR) filter comprising:  
a selection control means for selecting input data, the selection control means including:  
    a first n-bit shift register (n being a natural number) for progressively shifting the input data through successive stage bits,  
    n switching means respectively provided for outputs of the n stage bits of the n-bit shift register for controlling the outputs of these n bits, and  
    a control means for controlling the n switching means, the control means outputting n unique control signals respectively to the n switching means, the control means further being constituted by a second n-bit shift register for shifting a ramp-up/-down signal through successive bit stages under control of a shift clock for the first n-bit shift register; and  
    a multiplying means for multiplying data selected by the selection control means and a predetermined filter coefficient,  
    wherein a FIR filter output is derived from product outputs of the multiplying means.
3. (Previously presented): The FIR filter according to claim 2, wherein:  
the n switch means are each an AND gate for receiving the outputs of the corresponding bit stages of the first and second n-bit shift registers as respective inputs.

4. (Previously presented): The FIR filter according to claim 2, wherein:  
the n switching means are n switches provided for bit stages of the second n-bit shift register for selectively feeding out the filter coefficient data and zero data in response to the outputs of the corresponding bit stages.
5. (Previously presented): The FIR filter according to claim 2, wherein the outputs of the bit stages of the first n-bit shift register are reset on the basis of the outputs of the corresponding bit stage of the second n-bit shift register.
6. (Previously Presented) The FIR filter according to claim 2, which further comprises a means for changing a shift clock frequency of the first n-bit shift registers.
7. (Previously presented): The FIR filter according to claim 2, wherein the shifting operation of the first and second n-bit shift registers are operated under control of shift clock signals at different frequencies.
8. (Previously presented): The FIR filter according to claim 3, further comprising an adder circuit for adding together the outputs of the n multiplying circuits, wherein a ramp-up signal is fed to the first n-bit shift register, the ramp-up data being derived from the sum output of the adder circuit.
9. (Previously presented): The FIR filter according to claim 3, further comprising an adder circuit for adding together the outputs of the n multiplying circuits,

wherein a ramp-down signal is fed to the first n-bit shift register, the ramp-down data being derived from the sum output of the adder circuit.

10. (Previously presented): A Finite Impulse Response (FIR) filter comprising:  
a first n-bit shift register that receives an input signal and outputs n first-register output signals;

a control circuit that outputs n unique control signals;

an n-bit combining circuit coupled to the first n-bit shift register and coupled to the control circuit, the combining circuit combining the n output signals of the first n-bit shift register with the n unique control signals of the control circuit, the n-bit combining circuit outputting a combining circuit output signal;

n multipliers coupled to the n-bit combining circuit, each of the multipliers multiplying the combining circuit output signals with n filter coefficients, each of the n multipliers outputting a product; and

an adder coupled to the n multipliers, the adder adding the products of the n multipliers.

11. (Previously presented): The FIR filter according to claim 10, wherein the combining circuit consists of n logic gates.

12. (Previously presented): The FIR filter according to claim 11, wherein the logic gates are AND gates.

13. (Previously presented): The FIR filter according to claim 10, wherein an input to the control circuit is a ramp-up/ramp-down signal.

14. (Previously presented): The FIR filter according to claim 10, wherein the control circuit includes a second n-bit shift register.

15. (Previously presented): The FIR filter according to claim 14, wherein an input to the control circuit is a ramp-up/ramp-down signal.

16. (Previously presented): The FIR filter according to claim 10, further comprising:

a second clock signal supplied to the first n-bit shift register; and

a first clock signal supplied to the control circuit;

wherein the second clock signal has a different frequency than the first clock signal.

17. (Previously presented): A Finite Impulse Response (FIR) filter comprising:

a first n-bit shift register that receives an input signal and outputs a first-register output signal;

a control circuit that outputs n unique control signals;

n switching circuits, each switching circuit comprising:

a circuit for producing a fixed value;

a circuit for producing a FIR filter coefficient;

a switch coupled to the control circuit, coupled to the fixed value circuit

and coupled to the FIR filter coefficient circuit, each switch

selecting either the fixed value or the FIR filter coefficient

depending upon the control circuit output signal, outputting a switch selection output;

a multiplier coupled to the switch and coupled to the first n-bit shift

register, the multiplier multiplying the switch selection output with a selected one of the n first-register output signals to produce a switching circuit output; and

an adder coupled to the n switching circuits, the adder adding the outputs of the n switching circuits.

18. (Previously presented): The FIR filter according to claim 17, wherein an input to the control circuit is a ramp-up/ramp-down signal.

19. (Previously presented): The FIR filter according to claim 17, wherein the control circuit includes a second n-bit shift register.

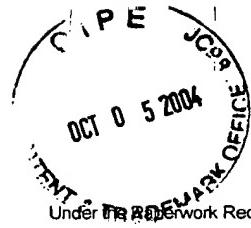
20. (Previously presented): The FIR filter according to claim 19, wherein an input to the control circuit is a ramp-up/ramp-down signal.

21. (Previously presented): The FIR filter according to claim 17, further comprising:

a second clock signal supplied to the first n-bit shift register; and

a first clock signal supplied to the control circuit;

wherein the second clock signal has a different frequency than the first clock signal.



AF #  
ZRW

PTO/SB/17 (10-03)

Approved for use through 7/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT**      **(\$)** 340.00

## Complete if Known

|                      |                        |
|----------------------|------------------------|
| Application Number   | 09/705,050-Conf. #3890 |
| Filing Date          | November 2, 2000       |
| First Named Inventor | Masahiko Nakayama      |
| Examiner Name        | C. C. Do               |
| Art Unit             | 2124                   |
| Attorney Docket No.  | F1866.0054             |

## METHOD OF PAYMENT (check all that apply)

Check     Credit Card     Money Order     Other     None

Deposit Account:

Deposit Account Number      50-2215

Deposit Account Name      Dickstein Shapiro Morin & Oshinsky LLP

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below     Credit any overpayments  
 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

#### Large Entity      Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description  | Fee Paid |
|----------|----------|----------|----------|--|----------|
| 1051     | 130      | 2051     | 65       | Surcharge - late filing fee or oath  |          |
| 1052     | 50       | 2052     | 25       | Surcharge - late provisional filing fee or cover sheet.                    |          |
| 1053     | 130      | 1053     | 130      | Non-English specification  |          |
| 1812     | 2,520    | 1812     | 2,520    | For filing a request for ex parte reexamination                            |          |
| 1804     | 920*     | 1804     | 920*     | Requesting publication of SIR prior to Examiner action                     |          |
| 1805     | 1,840*   | 1805     | 1,840*   | Requesting publication of SIR after Examiner action                        |          |
| 1251     | 110      | 2251     | 55       | Extension for reply within first month                                     |          |
| 1252     | 420      | 2252     | 210      | Extension for reply within second month                                    |          |
| 1253     | 950      | 2253     | 475      | Extension for reply within third month                                     |          |
| 1254     | 1,480    | 2254     | 740      | Extension for reply within fourth month                                    |          |
| 1255     | 2,010    | 2255     | 1,005    | Extension for reply within fifth month                                     |          |
| 1401     | 330      | 2401     | 165      | Notice of Appeal   |          |
| 1402     | 330      | 2402     | 165      | Filing a brief in support of an appeal                                     | 340.00   |
| 1403     | 290      | 2403     | 145      | Request for oral hearing   |          |
| 1451     | 1,510    | 1451     | 1,510    | Petition to institute a public use proceeding                              |          |
| 1452     | 110      | 2452     | 55       | Petition to revive - unavoidable   |          |
| 1453     | 1,330    | 2453     | 665      | Petition to revive - unintentional   |          |
| 1501     | 1,330    | 2501     | 665      | Utility issue fee (or reissue)   |          |
| 1502     | 480      | 2502     | 240      | Design issue fee   |          |
| 1503     | 640      | 2503     | 320      | Plant issue fee  |          |
| 1460     | 130      | 1460     | 130      | Petitions to the Commissioner  |          |
| 1807     | 50       | 1807     | 50       | Processing fee under 37 CFR 1.17(q)  |          |
| 1806     | 180      | 1806     | 180      | Submission of Information Disclosure Stmt                                  |          |
| 8021     | 40       | 8021     | 40       | Recording each patent assignment per property (times number of properties) |          |
| 1809     | 770      | 2809     | 385      | Filing a submission after final rejection (37 CFR 1.129(a))                |          |
| 1810     | 770      | 2810     | 385      | For each additional invention to be examined (37 CFR 1.129(b))             |          |
| 1801     | 770      | 2801     | 385      | Request for Continued Examination (RCE)                                    |          |
| 1802     | 900      | 1802     | 900      | Request for expedited examination of a design application                  |          |

Other fee (specify) \_\_\_\_\_

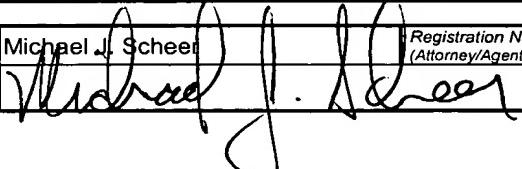
\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3) (\$)** 340.00

\*\*or number previously paid, if greater; For Reissues, see above

## SUBMITTED BY

(Complete if applicable)

|                   |   |                                      |        |           |                 |
|-------------------|---|--------------------------------------|--------|-----------|-----------------|
| Name (Print/Type) | Michael J. Scheer   | Registration No.<br>(Attorney/Agent) | 34,425 | Telephone | (212) 896-5472  |
| Signature         |  |                                      |        | Date      | October 5, 2004 |